

REMARKS

Favorable reconsideration of this application, in light of the following discussion and in view of the present amendment, is respectfully requested.

New claim 11 has been added. Claims 1-11 are pending and under consideration.

Applicants have timely filed a Request for Continued Examination (RCE) along with this Amendment, including the filing fee as set forth in 37 CFR 1.17(e). Accordingly, Applicants respectfully request that the Examiner withdraw the finality of any Office action and enter this Amendment for consideration under 37 CFR 1.114.

I. Claim Rejections

Claims 1-10 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3, 6 and 9 of US Patent 6,339,458 to Ohkawa.

The claims of the present application refer to a *rough area formed on and around* light scattering elements, distributed according to a predetermined pattern, such that the light scattering elements *and* an area surrounding the light scattering elements are *roughened*. The claims of Ohkawa refer only to dome-shaped roughened emission promotion regions that are distributed along an emission face along with other emission promotion regions with different covering densities. Ohkawa makes no mention of the emission face being roughened such that both of the distinct emission promotion regions and an area surrounding these regions become roughened. Therefore, Ohkawa does not disclose that *both* the light scattering elements *and* an area surrounding the light scattering elements are *roughened*, as is provided by the claims of the present invention. Accordingly, the claims of the present application are non-obvious in view of the claims of Ohkawa.

Because the claims of the present application and/or the claims of Ohkawa are non-obvious, the obviousness-type double patenting rejection should be withdrawn.

Furthermore, Applicants maintain that they are entitled to application of the two-way obviousness test. On page 3 of the Office Action, the Examiner states that the two-way test for obviousness-type double patenting can only apply when applicant could not avoid separate filings, and then only if the Patent and Trademark Office controlled rates of prosecution to cause the later filed species claims to issue before claims for genus in an earlier application. The Examiner further indicates that the “two-way” test could not be applied in this case. Applicants

respectfully disagree.

The present application has a priority date of June 12, 1998. Ohkawa has a priority date of September 10, 1999. Applicant simply *did not know* of the Ohkawa invention at the time when the predecessor of the present application was filed. To avoid losing any rights associated with the claims of the present application, it was necessary to file the present application at the time it was filed. As such, Applicants submit that they could not have avoided separate filings. Furthermore, Applicants did not cause this earlier filed application to be pending beyond the patent date of Ohkawa.

According to the two way obviousness test, the claims of the present application must be obvious in view of the claims of Ohkawa and the claims of Ohkawa must be obvious in view of the present invention. As discussed above, the claims of the present application and/or the claims of Ohkawa are non-obvious. Accordingly, withdrawal of the obviousness-type double patenting rejection is respectfully requested.

II. New Claim

New claim 11 has been added. Claim 11 provides for a rough area formed on and around *column-shaped* light scattering elements, distributed according to a predetermined pattern, such that the light scattering elements and an area surrounding the light scattering elements are roughened. Ohkawa refers only to dome-shaped roughened projections, but makes no mention of column-shaped roughened projections. Accordingly, claim 11 is non-obvious in view of Ohkawa. Thus, it is submitted that claim 11 is in a condition suitable for allowance.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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